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**REMARKS**

Applicant respectfully requests the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

Claims 1-19 are pending in this application. Claims 1-4, 6-7, 12-13 and 16-18 have been withdrawn from consideration. Claims 8-11 have been amended. These amendments are obviously for clarification purposes and are non-narrowing in scope. Thus, Applicant reserves the right to pursue any equivalent feature of the pending claims. No new matter has been added.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

**Election/Restriction**

The Office Action at page 2 states that claims 12, 13 and 16-18 are withdrawn from consideration. Applicant submits that claim 19 further limits method claim 7 (which has also been withdrawn).

**Allowable Subject Matter**

Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including

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all of the limitations of the base claim and any intervening claims. Applicant thanks the Examiner for the consideration given these claims. However, Applicant respectfully requests reconsideration of the other disputed claims as stated below.

***Issues Under 35 U.S.C. § 103(a)***

Claims 5, 11, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hirukawa et al. '095 (JP 11139095 A) in view of Yang '044 (U.S. Patent No. 5,594,044). Applicant's previous arguments are rendered moot in view of this new rejection. Applicant respectfully traverses this rejection, and reconsideration and withdrawal are respectfully requested.

***(A) A Prima Facie Case of Obviousness Has Not Been Formed***

The Office Action refers to parts of the primary reference of Hirukawa '095 for asserted disclosure of some of the features of the present invention. Further, the Office Action refers Applicant to the disclosure at Col. 4, lines 10-15 of the secondary reference of Yang '044 with regard to a hydroxyl value and a weight-average molecular weight range.

However, Applicant respectfully submits that the cited combination is improper since the Yang '044 reference belongs to a non-analogous art. Specifically, Yang '044 describes ink jet printing compositions at

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portions of Cols. 1 and 2; Col. 3, lines 14-20; Col. 4, line 45; Col. 6, line 7; etc. Yang '044 further describes such ink jet compositions in Example 1 and in claims 1-18 (at Cols. 8-10). Thus, Applicant respectfully disagrees that Yang '044 discloses or teaches any golf ball having a basic resin with polyurethane, as stated in the Office Action (i.e., see the last two lines of page 3).

In addition, Hirukawa '095 cannot be properly combined with Yang '044 because the requisite motivation and reasonable expectation of success are lacking. See *In re Vaeck*, 947 F.2d, 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). There are three possible sources of motivation to combine references: the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Here, one of ordinary skill in the art would not refer to the Yang '044 reference upon a reading of Hirukawa '095. This is because Yang '044 is directed to ink jet compositions, wherein such compositions must meet rigid requirements. Such requirements include the proper viscosity, resistivity, solubility, compatibility of components and the wettability of a substrate, which are further described in this reference at Col. 1, lines 20-43. Such different, rigid requirements are needed, for instance, to resist alcohol rubs and in order to spray the ink droplets onto the sheets of paper without clogging the nozzle.

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The Yang' 044 reference is in contrast to the present invention, and one of ordinary skill in Applicant's art would not know how to proceed in achieving the present invention upon reading Yang '044. In contrast to the requirements for ink jet compositions, the heat-transfer method for the composition of the present invention requires a relatively low temperature for transferability. In the present invention, the golf ball ink has to be softened at a relatively low temperature in order to have the proper thermal fusion bonding of the transferred pattern (Applicant explains this procedure in the present specification at page 6, lines 7-10).

Thus, because Yang '044 is directed to a different art, one of ordinary skill in the art would not refer to Yang '044 based on the nature of the problem to be solved (i.e., a novel ink for a golf ball, and not to print sheets of paper), the teaching of this reference (ink jet compositions, not golf balls), and the knowledge within the ordinary skill of such an artisan (different components and requirements, such as no clogging of the nozzle, for an ink jet composition requires a different artisan). Applicant further submits that the requisite reasonable expectation of success is lacking for those reasons stated above.

Therefore, Applicant respectfully submits that not all requirements for a *prima facie* case of obviousness have been satisfied.

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Reconsideration and withdrawal of this rejection is respectfully requested.

Further, while the reference need not expressly teach that the disclosure contained therein should be combined with another, see *Motorola, Inc. v. Interdigital Tech. Corp.*, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combining references "must be clear and particular". See *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). There is no "clear and particular" guidance in any of the cited references to achieve the formulations as presently claimed. For instance, nothing in Yang '044 states that its ink jet composition is acceptable for use on a golf ball, nor does Hirukawa '095 refer to Yang '044 to account for its own deficiencies. Thus, the references of Hirukawa '095 and Yang '044 have been improperly combined.

This deficiency is in addition to how Hirukawa '095 fails to disclose a molecular weight range of 20,000-60,000 for a polyurethane ink as in the golf ball of the present invention.

Applicant submits that the disclosure of Yang '044 is improperly cited for another reason. That other reason is that the molecular weight of the polyurethane of Yang '044 is determined in view of the requirements for ink jet printing. The requirements for ink jet printing are not the same as those of transfer printing of the present invention.

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In addition, the USPTO refers to Yang '044 for asserted disclosure of "a hydroxyl value having a weight-average molecular weight of 20,000 to 60,000", and refers Applicant to Col. 4, line 10-15 of this reference (at page 3 of the Office Action). However, Yang '044 discloses different weight ranges (*i.e.*, "5,000 to about 50,000 are preferred"; "20,000 to about 24,000 are even more preferred" at Col. 4) because Yang '044 is directed to ink jet compositions. The inconsistency in the ranges between Yang '044 and the present invention is due to the different requirements for the polyurethane contained in the ink of the ink jet compositions of Yang '044, versus the transfer ink printing for a golf ball. Therefore, Applicant respectfully submits that one of ordinary skill in the art would not be motivated or reasonably expect to be successful in combining Hirukawa '095 with Yang '044 in order to achieve the present invention. Reconsideration and withdrawal of this rejection is respectfully requested.

*(B) Impermissible Hindsight Reconstruction*

With regard to the cited combination of references, the USPTO states that it would be obvious to combine the cited references since "the ink composition is at it's best for wear and durability when at that range" and the "good binding agent for the ink composition" (see pages 3-4 of the Office Action). However, it is unreasonable to phrase the requisite motivation in these terms. First, this approach does not

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take into account whatsoever of the specific technical problems which are clearly stated in the present specification (see pages 1-3; i.e., reduced adherence, etc.). The disclosure in Yang '044 does not even refer to golf balls. Further, there is no evidence that using the Yang '044 ink, or that Yang '044 discloses that its polyurethane, would even result in good binding or better wear and durability as asserted. Second, considering the motivation/state of the art in the Examiner's terms implicitly includes a direction to the solution to the problem. This itself is unreasonable because the cited references ought to be considered without the benefit of hindsight reconstruction. In the present circumstances, Applicant submits that it is much more appropriate to consider the problem to be solved as that phrased at pages 1-3 of the specification.

One having ordinary skill in the art, faced with the problem as described in the specification, would not refer to the cited Yang '044 reference when seeking a solution. Even if this reference were considered, one having ordinary skill in the art would not know how to proceed since the reference is completely silent about golf balls themselves or the requirements in making the ink of the present invention (i.e., softening at a relatively low temperature for transfer printing).

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Thus, reconsideration and withdrawal of this rejection is respectfully requested because impermissible hindsight reconstruction has been used.

### **Conclusion**

A full and complete response has been made to all issues as cited in the Office Action. Applicant has taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicant respectfully requests that a timely Notice of Allowance issue for the present case.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Pursuant to 37 C.F.R. § 1.17 and 1.136(a), Applicant respectfully petitions for a one (1) month extension of time for filing a response in connection with the present application. The required fee of \$110.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees



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required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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